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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,489	07/31/2003	Carol A. DeLaVergne	DLV0002/US	4400
Kevin J. Hubbard KAGAN BINDER, PLLC Maple Island Building, Suite 200 221 Main Street North Stillwater, MN 55082				
EXAMINER				
PASCUA, JES F				
ART UNIT		PAPER NUMBER		
3782				
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11/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/632,489

**Applicant(s)**

DELAVERGNE, CAROL A.

**Examiner**

Jes F. Pascua

**Art Unit**

3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 10, 22, 28, 32-37, 39, 44 and 47-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 10, 22, 28, 32-37, 39, 44, 47 and 49-54 is/are rejected.
- 7) ☒ Claim(s) 2 and 48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/4/08, 8/15/08, 9/19/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 10, 49-51 and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,271,553 to Kim.

Kim discloses a reusable envelope comprising an enclosure defined by first and second panels (11, 12), a first removable panel (40), the first removable panel including a return address region and a postage region on opposing ends of the removable panel, a first underlying panel (22) underneath the first removable panel and a closure flap (47), the closure flap having first and second portions (49, 50) for securing the closure flap wherein the first and second portions of the flap are separable by lines of weakness (52, 53).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 44 rejected under 35 U.S.C. 103(a) as being unpatentable over Kim.

Kim discloses the claimed invention except for the first underlying panel (22) being a panel attached to the first panel of the enclosure and distinct from the first and second panels of the enclosure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the first underlying panel (22) of Kim as a panel attached to the first panel of the enclosure and distinct from the first and second panels of the enclosure (i.e. a distinct, transparent patch) since it was known in the art of envelopes that a distinct, transparent patch attached to the first panel of an envelope permits viewing of the envelope contents while protecting them.

5. Claims 1, 32-37, 47 and 49-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim and U.S. Patent No. 6,612,484 to Rawlings et al.

Kim discloses the claimed device except for the return address region and the postage region on the removable panel being separable from each other along a line of weakness. Rawlings et al. discloses that it is known in the art to provide a line of weakness (56) between the return address region and the postage region of an analogous envelope. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the removable panel of Kim with a line of weakness between the return address region and the postage region as taught by Rawlings et al., in order to provide a remittance portion that may be inserted within the envelope without folding.

6. Claims 22, 28 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO document no. WO 93/19991 to Husnu, U.S. Patent No. 759, 382 to Klugh and U.S. Patent No. 1,245,447 to Felenchak.

Husnu discloses the claimed device, especially a removable region/tear-away portion (30) on the front panel (14) for displaying an address. However, Hunsu does not disclose the first panel (14) of the envelope having additional removable regions/tear-away portions for displaying another address and postage mark. Klugh discloses that it is known in the art of reusable envelopes to provide a removable region/tear-away portion (C) for displaying an address and a similar, additional removable region/tear-away portion (D) for displaying a postage mark. Felenchak discloses that it is known in the art of reusable envelopes to provide a removable region/tear-away portion (8) for displaying an address and a similar, additional removable region/tear-away portion (12) for displaying another address. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the front panel of Husnu with additional removable regions/tear-away portions, that are similar to the removable region/tear-away portion (30), for displaying another address and postage mark as taught by Klugh and Felenchak, in order to facilitate remailing of the envelope. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the front panel of Husnu with additional removable regions/tear-away portions, that are similar to the removable region/tear-away portion (30), for displaying another address and postage mark, since it has been held that mere duplication of the essential working parts of a device involves only

routine skill in the art. The Klugh and Felenchak references are extrinsic evidence that support the statement of obvious duplication of essential working parts. Applicant's remarks, filed 08/15/2008, fail to argue the Examiner's mere duplication statement. Therefore, the Examiner's statement that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the front panel of Husnu with additional removable regions/tear-away portions, that are similar to the removable region/tear-away portion (30), for displaying another address and postage mark is taken to be admitted prior art.

Regarding claim 28, the modified Husnu envelope discloses the claimed invention, as discussed above, except for the closure flap having one or more access regions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the closure flap of Husnu with one or more access regions since it was known in the art that access regions on envelope closure flaps facilitate separating portions of the closure flap from each other.

***Allowable Subject Matter***

7. Claims 2 and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

8. Applicant's arguments filed 08/15/2008 have been fully considered but they are not persuasive.

Applicant remarks that the combination of Husnu, Klugh and Felenchak do not disclose a removable portion displaying both a first address and a postage mark and then a second removable portion displaying a second address as recited in amended claim 22. The "first portion" and "second portion" as claimed do not preclude a plurality of distinct sheets.

Applicant remarks that the combination of Husnu, Klugh and Felenchak do not disclose a tear-away portion displaying a first address and a postage mark, the tear-away portion being partially removable from the first panel to remove one of the first address and postage mark separately from the other as recited in amended claim 39. The "tear-away portion" as claimed does not preclude a plurality of distinct sheets with each sheet being removable from the panel of the envelope body separately from each other.

9. Applicant's arguments with respect to claims 1, 2, 10, 32-37, 44 and 47-54 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 714.02 and MPEP 2163.06. The "disclosure" includes the claims, the specification and the drawings.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 571-272-4546. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jes F. Pascua/  
Primary Examiner, Art Unit 3782